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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,558	10/15/2003	Charles Ray Ashcraft	11867-20	3491
757	7590	08/16/2006		
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610				
			EXAMINER CORDRAY, DENNIS R	
			ART UNIT 1731	PAPER NUMBER

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/686,558	<b>Applicant(s)</b> ASHCRAFT ET AL.	
	<b>Examiner</b> Dennis Cordray	<b>Art Unit</b> 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6 and 28-33 is/are rejected.
- 7) ☒ Claim(s) 2-5 and 7-27 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |  |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/19/04</u> . | 6) <input type="checkbox"/> Other: ____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6 and 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myracle, Jr. (5191906) in view of Montoya et al (5092353) and further in view of Matthews et al (4622983).

Myracle, Jr. discloses a cigarette wrapping paper comprising circumscribing bands of paper at intervals along the longitudinal axis of the paper (one layer). The bands can be made from conventional cigarette paper or paper chemically treated to affect burn rate (col 1, line 63 to col 2, line 3; col 2, lines 44-49). The bands are approximately 5 mm wide and are spaced at intervals from 5-20 mm (Claims 5 and 6). The bands are attached to the base wrapping paper by adhesive applied to the band (second layer). A paper made in a conventional process will inherently have two major surfaces, a wire side and a felt side. The application of the bands is done in a separate process (Fig. 1; col 2, lines 42-44), thus the pattern can be applied to either side of the paper, depending on how it is rolled in the original manufacturing process. The banded paper can be wrapped around a tobacco plug (smokable material) to form a cigarette (col 2, lines 21-25).

Art Unit: 1731

Myracle, Jr. discloses that the paper can comprise flax or other cellulosic fiber (col 3, lines 34-36) but does not disclose calcium carbonate filler or ethyl cellulose.

Montoya et al discloses a cigarette paper consisting essentially of flax and calcium carbonate, which is treated with a film forming agent to affect the burn rate. The film forming agent can be ethyl cellulose and is applied in an amount from 1-10% of the dry paper weight (col 5, lines 20-66). Other film forming agents include carboxy methyl cellulose, xanthan gum, arabic gum, guar gum, alginates and starches.

Matthews et al discloses a cigarette paper comprising flax and from 5 to 35% calcium carbonate and up to 50% inorganic fillers, which can be treated with a film forming material to affect the burning rate (Abs.; col 4, lines 27-36; col 7, lines 51-61). Disclosed film forming materials include methyl cellulose, carboxy methyl cellulose, vegetable gums, guar gum, alginates, and starches. Examples are given of a paper consisting of flax pulp, 12% titanium oxide filler, 1-2% calcium carbonate filler, and 3.6% potassium citrate, the paper having a basis weight of 24 g/m<sup>2</sup> (col 7, lines 20-30, Example 3). The paper was further treated with 1% film forming material and 9% potassium citrate (col 7, lines 39-48, Example 4). In this paper, the amount of calcium carbonate was equal to or greater than the amount of film forming material.

The art of Myracle, Jr., Montoya et al, Matthews et al and the instant invention are analogous as pertaining to cigarette wrappers treated to alter the burning rate. It would have been obvious to one of ordinary skill in the art to use a flax and calcium carbonate containing paper treated with ethyl cellulose to form the bands of the paper of Myracle, Jr. in view of Montoya et al and further in view of Matthews et al as a known

Art Unit: 1731

conventional chemically treated paper and functionally equivalent option. Since such papers can have up to 35% calcium carbonate and up to 10% ethyl cellulose, the amount of calcium carbonate can be greater than the amount of ethyl cellulose. The base paper made can have the claimed inherent porosity because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

***Allowable Subject Matter***

Claims 2-5 and 7-27 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The prior art does not disclose or suggest a wrapping paper with a multilayer pattern applied to the paper, the pattern comprising calcium carbonate and ethyl cellulose with a plasticizer, a wetting agent, and/or an optical brightener. Plasticizers, wetting agents and optical brighteners are used separately in other portions of the cigarette, such as in the filter, base wrapping paper or in the smokable filler, but not in an applied pattern to the wrapper. Also the prior art discloses 3 to 4 layer patterns comprising calcium carbonate in an amount much lower than the film-forming binder (Peterson et al, 5878754).

**Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure [Baker et al (4077414), Peterson et al (5878754)]. They pertain to other tobacco wrapping papers having spaced bands to control burning.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DRC



ERIC HUG  
PRIMARY EXAMINER